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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92029390
Party	Defendant Florence Fashions (Jersey) Limited
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Kenneth H. Leichter/
Date	05/19/2009
Attachments	Motion for Leave to Amend Answer.pdf ( 10 pages )(384703 bytes ) Exhibits to Motion for Leave to Amend.pdf ( 46 pages )(1855735 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VALENTINO USA, INC.  Opposer/Petitioner,  v.  FLORENCE FASHIONS (JERSEY) LIMITED,  Applicant/Registrant	Opposition Nos. 91094961 91095203 Cancellation Nos. 92029390 92029476
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**APPLICANT/REGISTRANT’S MOTION FOR LEAVE TO FILE AMENDED ANSWERS**

Pursuant to Rule 15 of the Federal Rules of Civil Procedure and 37 CFR §§ 2.107 and 2.115, Applicant/Registrant Florence Fashions (Jersey) Limited (“Florence Fashions”), moves to amend its Answers in each of these consolidated opposition and cancellation proceedings to assert the affirmative defense that Opposer/Petitioner Valentino USA, Inc.’s (“VUSA”)<sup>1</sup> asserted common law marks are comprised of or contain the common surname VALENTINO; that the marks are primarily merely a surname and lack distinctiveness; that VUSA cannot establish that its marks acquired distinctiveness before Florence Fashions’ 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing date of Florence Fashions’ applications; and that VUSA cannot establish priority or proprietary rights in the marks.<sup>2</sup> This motion

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<sup>1</sup> Valentino Couture, Inc. (“VC”) was the original Petitioner and Opposer in these proceedings. However, pursuant to the Board’s April 24, 2009 Order, these cases have been recaptioned to substitute VUSA for VC as Petitioner/Opposer.

<sup>2</sup> Florence Fashions has also amended certain non-substantive typographical errors in each of the Answers.

is accompanied by an amended Answer for each of the consolidated proceedings, attached as Exhibits A-D.<sup>3</sup>

## **I. RELEVANT BACKGROUND FACTS**

### **A. Procedural History**

In Opposition Nos. 91094961 and 91095203, and Cancellation Nos. 92029390 and 92029476 (collectively “the Consolidated Proceedings”), VUSA pleaded allegations, including likelihood of confusion and a false suggestion of a connection, based on various U.S. Trademark Registrations for the VALENTINO and/or VALENTINO GARAVANI marks (“the VS Registrations”). VUSA did *not* (and could not) allege ownership of those registrations because it was merely the alleged licensee of the pleaded marks.

On February 12, 2007, VUSA filed a motion for summary judgment on the ground of likelihood of confusion, and attempted to rely on the VS Registrations in support of that claim. Florence Fashions opposed the motion. In an order dated May 19, 2008, the Board denied VUSA’s motion and determined that VUSA could not rely on the presumptions afforded by the VS Registrations, that the record was unclear as to evidence of VUSA’s actual use of its marks, and that material issues of fact remained as to VUSA’s priority.

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<sup>3</sup> Florence Fashions believes that its denial of VUSA’s priority and likelihood of confusion claims in the prior Answers filed in these proceedings are sufficient to place the burden on VUSA to establish prior use and ownership in a protectable mark. It is well settled that to prevail on a claim of likelihood of confusion based on common law rights in a mark, a plaintiff must prove that its mark is distinctive, inherently or through acquired distinctiveness, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317 (CCPA 1981). However, Florence Fashions is seeking an amendment at this time so that there is no question that VUSA is on notice of Florence Fashions’ contention that VUSA cannot establish priority or ownership of a distinctive mark in these cases.

On November 10, 2008, VUSA filed a motion to join the owner of the registrations, Valentino S.p.A. ("VS"), as a party to the Consolidated Proceedings, and to recaption the proceeding with VS as the Opposer/Petitioner.

Florence Fashions opposed VUSA's motion to join on November 25, 2008 on the ground that joinder was improper because VUSA was not the owner of the registrations at the time the Consolidated Proceedings were initiated.

On November 14, 2008, VUSA filed a Notice of Reliance Under Rule 2.122(d)(2) seeking to submit the VS Registrations as evidence in these proceedings. Florence Fashions moved to strike VUSA's 2.122(d)(2) Notice of Reliance on December 1, 2008 on the ground that VUSA was not the owner of the VS Registrations, and that the owner, VS, could not be joined as a party.

On December 15, 2008, the Board denied VUSA's motion to join VS as a party to these proceedings. However, the Board provided VUSA with an additional 25-day testimony period solely for the limited purpose of submitting evidence of use of its marks:

While plaintiff's lack of diligence cannot be excused, we find that under the circumstances, plaintiff should have all of the time that remained in its testimony period on the day it filed its renewed motion to join, so that it has every opportunity to introduce evidence of its use of its marks. See Board Order (Dec. 15, 2008) at 4-5.

Accordingly, the remaining testimony period for VUSA was reset for January 5-30, 2009.

As a result of the Board's December 15, 2008 order, VUSA filed a motion to withdraw its Notice of Reliance on the VS Registrations on December 22, 2008, thus mooted Florence Fashions' December 1, 2008 motion to strike.

On March 3, 2009, however, VUSA filed a Notice of Reliance under Rule 2.122(e), submitting once again copies of the VS Registrations (VUSA's Second Notice of Reliance). The Second Notice of Reliance stated "These registrations will be relied on and are relevant to this proceeding as Petitioner/Opposer is the exclusive-licensee and user of the above marks."

On March 18, 2009, Florence Fashions filed a motion to strike VUSA's Second Notice of Reliance on the ground that the evidence sought to submit is irrelevant to the issue of VUSA's use of its marks pleaded in the proceedings and was beyond the limited scope of the expanded testimony period provided by the Board in its December 15, 2008 order. Further, Florence Fashions contended VUSA could not rely on the ownership presumptions of the VS Registrations.

On April 24, 2009, the Board denied Florence Fashions' Motion to Strike VUSA's Second Notice of Reliance. In so ruling, the Board conclusively recognized that VUSA has conceded that it "cannot claim the Section 7(b) presumptions accorded to those registrations."

VUSA's testimony period originally opened on November 4, 2008, and, after several adjustments, closed on March 19, 2009. Florence Fashions' testimony opened on April 19, 2009 and closes on July 7, 2009. VUSA's 15-day rebuttal period closes on August 21, 2009.

**B. Florence Fashions' Recent Change of Counsel and Newly Discovered Relevant Evidence**

Florence Fashions retained new counsel shortly before the testimony stage of this case. Current counsel first appeared in the case on October 20, 2008, and VUSA's testimony period opened November 4, 2008.

On the eve of the May 14, 2008 testimony deposition of Florence Fashions' witness, James Norris, Florence Fashions made current counsel aware of information and documents related to its predecessor-in-interest's earlier date of first use in the United States in 1977. This information was only recently discovered because it was misplaced in files related to foreign proceedings.

Florence Fashions introduced an exhibit and testimony about the 1977 date of first use during Mr. Norris's testimony deposition. Opposing counsel attended and cross-examined the witness.

Moreover, on or about May 17, 2009, counsel for Florence Fashions discovered for the first time that VUSA recently filed a response to a PTO Office Office Action issued in connection Application Serial No. 79059290 for the mark VALENTINO. The PTO refused registration of VUSA's VALENTINO mark on the ground that it is primarily merely a surname, and counsel for VUSA filed a response to the Office Action amending the application under Section 2(f), 15 U.S.C. § 1052(f).<sup>4</sup> Thus, VUSA has admitted that the term VALENTINO is not inherently distinctive, and it was clearly on notice the VALENTINO mark is primarily merely a surname, and thus requires proof of acquired distinctiveness for registrability and protection.

## **II. ARGUMENT**

It is well settled that amendment of a pleading "should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of

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<sup>4</sup> See Exhibit E (Office Action issued and sent to counsel for VUSA in connection with Application Serial No. 79059290 for the mark VALENTINO finding the mark primarily merely a surname and counsel for VUSA's Response to Office Action amending application to Section 2(f) application).

justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971); See also Fed. R. Civ. P. 15; TBMP § 507.02 (“Leave must be freely given when justice so requires.”) (emphasis added).

**A. Florence Fashion’s Amendment is Timely**

In this case, justice clearly requires that Florence Fashions be allowed to amend its Answers to assert the affirmative defense that VUSA’s common law marks containing the term VALENTINO are primarily merely a surname and lack distinctiveness, and that VUSA cannot establish that its marks acquired distinctiveness before Florence Fashions’ 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing date of Florence Fashions’ applications.

Florence Fashions promptly filed this motion after the Board issued a series of recent orders holding that VUSA would not be able to rely on the VS Registrations for presumptions of priority and distinctiveness. The Board’s April 24, 2009 order finally determined that VUSA “cannot claim the Section 7(b) presumptions accorded to those registrations.”

Moreover, Florence Fashions filed this motion to amend promptly after the close of VUSA’s testimony period when it became clear based on VUSA’s testimony (and lack thereof) that VUSA cannot establish its common law marks containing VALENTINO are distinctive.

Likewise, Florence Fashions only recently discovered the evidence related to its earlier first-use date through its predecessor-in-interest. VUSA was put on notice of this

evidence during the deposition of Mr. Norris, and Florence Fashions acted promptly to file this motion following that deposition.

**B. VUSA Will Not Be Prejudiced by the Amendment**

It is well established that the Board liberally grants leave to amend pleadings at *any stage* of a proceeding when justice so requires. *Focus 21 Int'l, Inc. v. Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Cool-Ray Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974). In keeping with this liberal policy, the Board has granted motions for leave to amend pleadings during the testimony period. See *Am. Optical Corp.*, 168 USPQ 471 (applicant allowed to amend answer to add affirmative defenses after the close of opposer's testimony period); *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (allowing amendment during testimony period).

In this case, VUSA will not be prejudiced by the proposed amendment. The proceedings are in the early stages of Florence Fashions' testimony period. VUSA still has the several months before and its entire rebuttal period during which to address Florence Fashions' amended allegations and defense. Moreover, VUSA knew that it would have to address the issue of the protectability of its VALENTINO mark as part of its case in chief. Indeed, protectability is one of the required elements of its priority and likelihood of confusion claims. Moreover, at least as early as November 5, 2008 (one day into VUSA's original testimony period), VUSA's counsel was expressly placed on notice by the PTO that the VALENTINO mark is primarily merely a surname, and thus requires proof of secondary meaning for protection. (See Exhibit E). Accordingly, no unfair surprise will result from Florence Fashions' requested amendment. By contrast,



Florence Fashions will be greatly prejudiced if it is denied the chance to pursue its claim that VUSA's marks are weak and lack distinctiveness.

The Board has allowed such amendments at this stage of proceedings in an analogous case. In *Am. Optical Corp.*, after the close of opposer's period for taking testimony and before the opening of applicant's trial period, applicant moved for leave to file an amended answer alleging a date of first use substantially prior to the date claimed in its initial answer and to plead a registration. See 168 USPQ at 472. Applicant sought this amendment after its recently-appointed attorney visited its offices and learned, for the first time, of the earlier use and registration. See *Id.* Opposer argued it would be prejudiced because its testimony period had terminated and it had "predicated its entire case" on the date claimed in the original answer. See *Id.* at 472-73. The Board found no prejudice and allowed the amendment, noting applicant's argument that opposer could respond to the amended pleading in its rebuttal period. See *Id.* at 473.

In addition, in support of its amended affirmative defense, Florence Fashions is relying primarily on public information or information uniquely in control of VUSA to support its contention that VALENTINO lacks distinctiveness. Thus, there is no need to reopen proceedings and VUSA will have an opportunity to respond to this evidence during its rebuttal testimony period, if so desired.

**C. Florence Fashions' Proposed Amendment is Legally Sufficient**

Finally, amendment should be allowed in this case because Florence Fashions' amended affirmative defense is legally sound. The allegations set out in Paragraphs 18 (Cancellation No. 92029390), 19 (Cancellation No. 92029476), and 22 (Opposition Nos.

91094961 and 91095203) in the attached Amended Answers adequately state the basis for Florence Fashions' affirmative defense that VUSA's common law marks are primarily merely a surname and lack distinctiveness; that VUSA cannot establish that its marks acquired distinctiveness before Florence Fashions' 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing date of Florence Fashions' applications; and that VUSA cannot establish priority or proprietary rights in the marks. *See Otto Roth & Co.*, 640 F.2d 1317 (in order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use.).

### III. CONCLUSION

Based on the facts and authorities set forth above, Florence Fashions respectfully requests that the Board give leave to file the attached Amended Answers.

Respectfully submitted,

Date: May 19, 2009

By:



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Attorneys for Applicant/Registrant

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing  
APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER,  
EXHIBITS A - D (AMENDED ANSWERS AND AFFIRMATIVE DEFENSES TO  
OPPOSITION NOS. 91094961 and 91095203 and CANCELLATION NOS. 92029390  
and 92029476, respectively) and EXHIBIT E (Office Action and Response to Office Action  
for App. Ser No. 79059290) was served by first class mail, postage prepaid, on this 19th  
day of May 2009, upon counsel for Opposer/Petitioner:

G. Franklin Rothwell  
Anne Sterba  
Rothwell Figg Ernst & Manbeck PC  
1425 K Street, NW  
Washington, DC 20005



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VALENTINO USA, INC. v. FLORENCE FASHIONS (JERSEY) LIMITED

Opposition Nos. 91094961

91095203

Cancellation Nos. 92029390

92029476

**APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Exhibit A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>VALENTINO USA, INC.<sup>1</sup></b>  Opposer/Petitioner  v.  <b>FLORENCE FASHIONS (JERSEY) LIMITED</b>  Applicant/Registrant	Opposition No.        91094961  Consolidated with:  Opposition No.        91095203 Cancellation Nos.    92029390 92029476
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**AMENDED ANSWER AND AFFIRMATIVE DEFENSES  
TO AMENDED NOTICE OF OPPOSITION**

Applicant Florence Fashions (Jersey) Limited, by its attorneys and pursuant to the Trademark Rules of Practice, hereby files its Amended Answer and Affirmative Defenses to the Amended Notice of Opposition filed in the above-referenced proceedings.

**ANSWER**

**COUNT I**

1. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and therefore all such allegations are denied.

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<sup>1</sup> Valentino Couture, Inc. was the original Petitioner and Opposer in these proceedings. However, pursuant to the Board's April 24, 2009 Order, this case has been recaptioned to substitute Valentino USA, Inc. as Petitioner/Opposer.

2. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and therefore all such allegations are denied.

3. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and therefore all such allegations are denied.

4. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 4, and therefore all such allegations are denied.

5. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 5, and therefore all such allegations are denied.

6. Applicant is without information sufficient to form a belief as to the existence or status of the trademarks and registrations set forth in Paragraph 6, and therefore all allegations regarding such marks and registrations, and all other allegations in Paragraph 6 are denied.

7. All allegations in Paragraph 7 are denied.

8. Applicant admits that at the time it adopted its mark it had heard of the names VALENTINO and VALENTINO GARAVANI, but denies all other allegations in Paragraph 8.

9. All allegations in Paragraph 9 are denied.

10. All allegations in Paragraph 10 are denied.

## **COUNT II**

11. Applicant realleges and incorporates herein by reference its answers to Paragraphs 1-10 above as if fully set forth herein.

12. All allegations in Paragraph 12 are denied.

13. All allegations in Paragraph 13 are denied.

### **COUNT III**

14. Applicant realleges and incorporates herein by reference its answers to Paragraphs 1-13 above as if fully set forth herein.

15. All allegations in Paragraph 15 are denied.

16. All allegations in Paragraph 16 are denied.

### **AFFIRMATIVE DEFENSES**

17. There is no likelihood of confusion, mistake, or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the two are not confusingly similar.

18. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the goods on which each party uses or intends to use their respective marks are different, as are their respective markets and channels of trade, rendering confusion between them unlikely.

19. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the

sophistication and discriminating nature of the customers for the products of each party deem it unlikely that confusion between the marks will occur.

20. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the marks are not confusingly similar. Any similarity which may exist between the two would be the result of their respective use of the term "valentino," which has been used and registered by numerous third parties in the clothing, clothing-related, and other fields. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant on use of the term "valentino."

21. Opposer is estopped from opposing Applicant's application herein as the result of a 1979 Agreement limiting Opposer's rights to the pleaded marks, and allowing use of the term "valentino" in marks for, inter alia, clothing and leather goods. Those limitations are a bar to the opposition filed herein.

22. The pleaded common law marks are comprised of or contain the common surname VALENTINO. The pleaded marks are primarily merely a surname and lack distinctiveness. Opposer cannot establish that the pleaded marks acquired distinctiveness before Applicant's 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing dates of Applicant's applications. Thus, Opposer cannot establish priority or proprietary rights in the marks.


WHEREFORE, Applicant asks that the Amended Notice of Opposition be dismissed in its entirety, and that a registration issue to Applicant for its applied-for mark.



Respectfully submitted,

Date: May 19, 2009

By:

  
\_\_\_\_\_  
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Attorneys for Applicant/Registrant

VALENTINO USA, INC. v. FLORENCE FASHIONS (JERSEY) LIMITED

Opposition Nos. 91094961

91095203

Cancellation Nos. 92029390

92029476

**APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Exhibit B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>VALENTINO USA, INC.<sup>1</sup></b>  Opposer/Petitioner  v.  <b>FLORENCE FASHIONS (JERSEY) LIMITED</b>  Applicant/Registrant	Opposition No.        91095203  Consolidated with:  Opposition No.        91094961 Cancellation Nos.    92029390 92029476
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**AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO  
AMENDED NOTICE OF OPPOSITION**

Applicant Florence Fashions (Jersey) Limited, by its attorneys and pursuant to the Trademark Rules of Practice, hereby files its Amended Answer and Affirmative Defenses to the Amended Notice of Opposition filed in the above-referenced proceedings.

**ANSWER**

**COUNT I**

1. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and therefore all such allegations are denied.

---

<sup>1</sup> Valentino Couture, Inc. was the original Petitioner and Opposer in these proceedings. However, pursuant to the Board's April 24, 2009 Order, this case has been recaptioned to substitute Valentino USA, Inc. as Petitioner/Opposer.

2. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and therefore all such allegations are denied.

3. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and therefore all such allegations are denied.

4. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 4, and therefore all such allegations are denied.

5. Applicant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 5, and therefore all such allegations are denied.

6. Applicant is without information sufficient to form a belief as to the existence or status of the trademarks and registrations set forth in Paragraph 6, and therefore all allegations regarding such marks and registrations, and all other allegations in Paragraph 6 are denied.

7. All allegations in Paragraph 7 are denied.

8. Applicant admits that at the time it adopted its mark it had heard of the names VALENTINO and VALENTINO GARAVANI, but denies all other allegations in Paragraph 8.

9. All allegations in Paragraph 9 are denied.

10. All allegations in Paragraph 10 are denied.

## **COUNT II**

11. Applicant realleges and incorporates herein by reference its answers to Paragraphs 1-10 above as if fully set forth herein.

12. All allegations in Paragraph 12 are denied.

13. All allegations in Paragraph 13 are denied.

### **COUNT III**

14. Applicant realleges and incorporates herein by reference its answers to Paragraphs 1-10, 12 and 13 as if fully set forth herein.

15. All allegations in Paragraph 15 are denied.

16. All allegations in Paragraph 16 are denied.

### **AFFIRMATIVE DEFENSES**

17. There is no likelihood of confusion, mistake, or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the two are not confusingly similar.

18. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the goods on which each party uses or intends to use their respective marks are different, as are their respective markets and channels of trade, rendering confusion between them unlikely.

19. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the

sophistication and discriminating nature of the customers for the products of each party deem it unlikely that confusion between the marks will occur.

20. There is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because, inter alia, the marks are not confusingly similar. Any similarity which may exist between the two would be the result of their respective use of the term "valentino," which has been used and registered by numerous third parties in the clothing, clothing-related, and other fields. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant on use of the term "valentino."

21. Opposer is estopped from opposing Applicant's application herein as the result of a 1979 Agreement limiting Opposer's rights to the pleaded marks, and allowing use of the term "valentino" in marks for, inter alia, clothing and leather goods. Those limitations are a bar to the opposition filed herein.

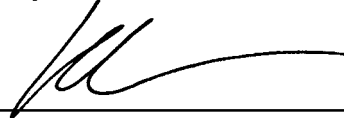
22. The pleaded common law marks are comprised of or contain the common surname VALENTINO. The pleaded marks are primarily merely a surname and lack distinctiveness. Opposer cannot establish that the pleaded marks acquired distinctiveness before Applicant's 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing dates of Applicant's applications. Thus, Opposer cannot establish priority or proprietary rights in the marks.

WHEREFORE, Applicant asks that the Amended Notice of Opposition be dismissed in its entirety, and that a registration issue to Applicant for its applied-for mark.

Respectfully submitted,

Date: May 19, 2009

By:



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VALENTINO USA, INC. v. FLORENCE FASHIONS (JERSEY) LIMITED

Opposition Nos. 91094961

91095203

Cancellation Nos. 92029390

92029476

**APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Exhibit C



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>VALENTINO USA, INC.<sup>1</sup></b>  Opposer/Petitioner  v.  <b>FLORENCE FASHIONS (JERSEY) LIMITED</b>  Applicant/Registrant	  Cancellation No.     92029390  Consolidated with:  Opposition Nos.     91094961 91095203 Cancellation No.     92029476
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**SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES  
TO PETITION FOR CANCELLATION**

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Registrant Florence Fashions (Jersey) Limited ("Registrant"), hereby files its Second Amended Answer and Affirmative Defenses to the Petition for Cancellation filed by Valentino Couture, Inc. ("Petitioner") as follows:

**SECOND AMENDED ANSWER**

**COUNT I**

1. Registrant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and therefore all such allegations are denied.

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<sup>1</sup> Valentino Couture, Inc. was the original Petitioner and Opposer in these proceedings. However, pursuant to the Board's April 24, 2009 Order, this case has been recaptioned to substitute Valentino USA, Inc. as Petitioner/Opposer.

2. Registrant admits that 1991 is the constructive date of first use claimed in its subject Registration. Registrant is without information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 2, and therefore all such other allegations are denied.

3. Registrant admits that 1991 is the date of first use claimed in its subject Registration. Registrant is without information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 3, and therefore all such other allegations are denied.

4. Registrant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4, and therefore all such allegations are denied.

5. Registrant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5, and therefore all such allegations are denied.

6. The U.S. Trademark Register at the U.S. Patent and Trademark Office speaks for itself as to the status of the various registrations which Petitioners lists in Paragraph 6. Registrant is without information sufficient to form a belief as to the remaining allegations in Paragraph 6, and therefore all such other allegations are denied.

7. Registrant admits that the mark GIANNI VALENTINO was adopted by Registrant, that Registrant was aware of the name VALENTINO and VALENTINO GARAVANI at the time it adopted and began use of its mark GIANNI VALENTINO, but denies all remaining allegations in Paragraph 7.

8. Registrant denies the allegations in Paragraph 8.

9. Registrant denies the allegations in Paragraph 9.

### **COUNT II**

10. Registrant repeats and realleges the answers contained in Paragraphs 1-9 above as if the same were further set forth herein.

11. Registrant denies the allegations in Paragraph 11.

12. Registrant denies the allegations in Paragraph 12.

### **AFFIRMATIVE DEFENSES**

13. There is no likelihood of confusion, mistake, or deception between Petitioner's alleged marks and names and Registrant's mark because, inter alia, each party's respective marks and names are not confusingly similar.

14. There is no likelihood of confusion, mistake, or deception between Petitioner's alleged names and marks and Registrant's marks because, inter alia, the goods on which each party uses or intends to use the respective marks and names are dissimilar, as are their markets and channels of trade, rendering confusion between them unlikely.

15. There is no likelihood of confusion, mistake, or deception between Petitioner's alleged marks and names and Registrant's marks because, inter alia, the sophistication and discriminating nature of the customers for the products of each party deem it unlikely that confusion between the names and marks will occur.

16. There is no likelihood of confusion, mistake, or deception between Petitioner's alleged marks and names and Registrant's marks because, inter alia, the marks and names are not confusingly similar. Any similarity which may exist between these marks and names would be the result of their respective use of the term "VALENTINO," which has been used and registered by other third parties on clothing, and leather goods and other goods in these fields. As a result, Petitioners cannot base any similarity between its alleged marks and names and Registrant's mark on use of the term "VALENTINO" because it cannot claim any exclusivity in the use of that term.

17. Petitioner is estopped from canceling Registrant's registration herein, as a result of a 1979 Agreement limiting Petitioner's rights in its alleged marks and names, and allowing use of the term "VALENTINO" on marks for, inter alia, clothing and leather goods. Those limitations are a bar to the cancellation filed herein.


18. The pleaded common law marks are comprised of or contain the common surname VALENTINO. The pleaded marks are primarily merely a surname and lack distinctiveness. Petitioner cannot establish that the pleaded marks acquired distinctiveness before Registrant's 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing dates of Registrant's applications. Thus, Petitioner cannot establish priority or proprietary rights in the marks.

WHEREAS, Registrant asks that the Petition for Cancellation be dismissed in its entirety and that its Registration be allowed to remain on the Principal Register.

Respectfully submitted,

Date: May 19, 2009

By:

  
\_\_\_\_\_  
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Attorneys for Applicant/Registrant

VALENTINO USA, INC. v. FLORENCE FASHIONS (JERSEY) LIMITED

Opposition Nos. 91094961

91095203

Cancellation Nos. 92029390

92029476

**APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Exhibit D

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>VALENTINO USA, INC.<sup>1</sup></b>  Opposer/Petitioner  v.    <b>FLORENCE FASHIONS (JERSEY) LIMITED</b>  Applicant/Registrant	  Cancellation No.     92029476  Consolidated with:  Opposition Nos.     91094961 91095203 Cancellation No.     92029390
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**AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO  
AMENDED PETITION FOR CANCELLATION**

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Registrant Florence Fashions (Jersey) Limited ("Registrant"), by its attorneys, hereby files its Amended Answer and Affirmative Defenses to the Amended Petition for Cancellation filed by Valentino Couture, Inc. ("Petitioner") as follows:

**COUNT I**

1. Registrant is without information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and therefore all such allegations are denied.

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<sup>1</sup> Valentino Couture, Inc. was the original Petitioner and Opposer in these proceedings. However, pursuant to the Board's April 24, 2009 Order, this case has been recaptioned to substitute Valentino USA, Inc. as Petitioner/Opposer.

2. Registrant admits that 1991 is the constructive date of first use claimed in its subject Registration. Registrant is without information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 2, and therefore all such other allegations are denied.

3. Registrant admits that 1991 is the date of first use claimed in its subject Registration. Registrant is without information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 3, and therefore all such other allegations are denied.

4. Registrant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4, and therefore all such allegations are denied.

5. Registrant is without information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5, and therefore all such allegations are denied.

6. The U.S. Trademark Register at the U.S. Patent and Trademark Office speaks for itself as to the status of the various registrations which Petitioner lists in Paragraph 6. Registrant is without information sufficient to form a belief as to the remaining allegations in Paragraph 6, and therefore all such other allegations are denied.

7. Registrant admits that the mark GIOVANNI VALENTINO was adopted by Registrant, that Registrant was aware of the name VALENTINO and VALENTINO GARAVANI at the time it adopted and began use of its mark GIOVANNI VALENTINO, but denies all remaining allegations in Paragraph 7.



8. Registrant denies the allegations in Paragraph 8.
9. Registrant denies the allegations in Paragraph 9.
10. Registrant denies the allegations in Paragraph 10.

### **COUNT II**

11. Registrant repeats and realleges the answers contained in Paragraphs 1-10 above as if the same were further set forth herein.

12. Registrant denies the allegations in Paragraph 12.
13. Registrant denies the allegations in Paragraph 13.

### **AFFIRMATIVE DEFENSES**

14. There is no likelihood of confusion, mistake, or deception between Petitioner Valentino Couture, Inc.'s ("Petitioner VC") alleged marks and names and Registrant's mark because, inter alia, each party's respective marks and names are not confusingly similar.

15. There is no likelihood of confusion, mistake, or deception between Petitioner VC's alleged names and marks and Registrant's marks because, inter alia, the goods on which each party uses or intends to use the respective marks and names are dissimilar, as are their markets and channels of trade, rendering confusion between them unlikely.

16. There is no likelihood of confusion, mistake, or deception between Petitioner VC's alleged marks and names and Registrant's marks because, inter alia,

the sophistication and discriminating nature of the customers for the products of each party deem it unlikely that confusion between the names and marks will occur.

17. There is no likelihood of confusion, mistake, or deception between Petitioner VC's alleged marks and names and Registrant's marks because, inter alia, the marks and names are not confusingly similar. Any similarity which may exist between these marks and names would be the result of their respective use of the term "VALENTINO," which has been used and registered by other third parties on clothing, and leather goods and other goods in these fields. As a result, Petitioners cannot base any similarity between its alleged marks and names and Registrant's mark on use of the term "VALENTINO" because it cannot claim any exclusivity in the use of that term.

18. Petitioner VC is estopped from canceling Registrant's registration herein, as a result of a 1979 Agreement limiting Petitioner VC rights in its alleged marks and names, and allowing use of the term "VALENTINO" on marks for, inter alia, clothing and leather goods. Those limitations are a bar to the cancellation filed herein.

19. The pleaded common law marks are comprised of or contain the common surname VALENTINO. The pleaded marks are primarily merely a surname and lack distinctiveness. Petitioner cannot establish that the pleaded marks acquired distinctiveness before Registrant's 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing dates of Registrant's applications. Thus, Petitioner cannot establish priority or proprietary rights in the marks.

WHEREAS, Registrant asks that the Amended Petition for Cancellation be dismissed in its entirety and that its registration be allowed to remain on the Principal Register.

Respectfully submitted,

Date: May 19, 2009

By:



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VALENTINO USA, INC. v. FLORENCE FASHIONS (JERSEY) LIMITED

Opposition Nos. 91094961

91095203

Cancellation Nos. 92029390

92029476

**APPLICANT/REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Exhibit E

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/059290

**MARK:** VALENTINO

**\*79059290\***

**CORRESPONDENT ADDRESS:**

JACOBACCI & PARTNERS S.P.A.  
Via Senato, 8  
I-20121 MILANO  
ITALY

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** VALENTINO S.P.A.

**CORRESPONDENT'S**

**REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:**

**INTERNATIONAL REGISTRATION NO. 0978396.**

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c).

**WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:**

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, the only attorneys who can practice before the USPTO in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and**

(2) **Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).

37 C.F.R. §§10.1(c), 10.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. A response signed by an unauthorized foreign attorney is considered an incomplete response. *See* TMEP §§602.03, 712.03.

#### **THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

#### **I. SEARCH OF THE OFFICE RECORDS**

##### **Application Refused--Section 2(d) Refusal—Likelihood of Confusion**

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods and/or services, so resembles the marks in U.S. Registration Nos. 1820548, 1210075, and 1210072 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §1207.01 *et seq.* Please see the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

The applicant's proposed mark is VALENTINO; the registered marks are VALENTIN, VALENTINO'S and VALENTINO'S (stylized).

##### **Comparison of the Respective Marks**

In a likelihood of confusion determination, the examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476

F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973); TMEP §1207.01(b). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB (1988)); *In re Mack*, 197 USPQ 755 (TTAB 1977); *see* TMEP §§1207.01(b).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *See Racot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed Cir. 2000); *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The examining attorney refuses registration of the proposed mark VALENTINO on the grounds that it will cause a likelihood of confusion with the registered VALENTIN, VALENTINO'S and VALENTINO'S (stylized) marks. The applicant's proposed mark so resembles the registered marks as to render confusion as to source likely. Indeed, the marks are essentially phonetic equivalents. Similarity in sound alone has been found sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.* 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv). The Board has held that pluralization of a mark is generally not significant. *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985). Because the applicant's proposed mark so resembles the registered marks in relation to sound, appearance, and meaning, confusion as to source is likely.

#### Comparison of the Respective Goods and/or Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc v. America Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

If the marks of the respective parties are identical or highly similar, the relationship between the goods and/or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

The examining attorney refuses registration of the mark VALENTINO because the channels of trade in which the applicant's goods and services travel are similar to those used by the registrant. The applicant's goods and services are identified generally as financial services, real estate services, food and beverage services, providing temporary accommodations, and heating, cooling, cooking, and steam generating apparatus. The goods named in the U.S. Registration No. 1820548 (VALENTIN) comprise "shower equipment sold as a unit; namely, nozzles, massaging and regular shower heads, hoses,

adjustable, sliding and swivel brackets, wall outlets, sockets and cradles.”

The services named in the U.S. Registration Nos. 1210075 (VALENTINO’S) and 1210072 (VALENTINO’S (stylized)) both comprise “restaurant services.”

Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii).

When the application describes the goods and services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all goods and services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive . . . . There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a)(iii). In this case, the applicant’s used the class headings as its identification of goods and services. As such, the Office is required to presume that the applicant’s goods and services comprise all products and services that are properly found in each particular class, including the shower equipment and restaurant services specifically identified in the cited registration.

In addition, the examining attorney finds that the applicant’s financial and real estate services are related to the restaurant services listed in the cited VALENTINO’S registration in that it is quite common in the hotel and restaurant industry for entities that provide hotel resort and restaurant services to also provide financial and real estate services. As evidence that consumers are accustomed to a single source identifier in relation to these services, the examining attorney encloses ten (10) separate trademark registrations in which the same mark is used in relation to both restaurant services and real estate and financial services. These printouts have probative value to the extent that they serve to suggest that the identified services are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), *citing In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

Given the similarity between the respective marks, the relatedness of the goods and services, and the similarity between the channels of trade for these goods and services, it is likely that consumers will be confused as to the ultimate source of these products and services and associate the registered mark with the applicant’s proposed mark. Accordingly, the examining attorney refuses registration of the applicant’s proposed mark.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

#### **Prior Pending Applications**

During the search of the Office records, the examining attorney also discovered several potentially conflicting marks in prior-filed pending applications that may present a bar to registration.

Information regarding pending Application Serial Nos. 77041108, 77410807, 77346274, 75004284,



76156579, and 74341624 is enclosed. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion under Trademark Act Section 2(d) between the applicant's proposed mark and the referenced marks. If one or more of the referenced applications registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed applications.

If the applicant believes that there is no potential conflict between this application and the earlier-filed applications, then the applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits the applicant's right to address this issue at a later point.

## II. SUBSTANTIVE REFUSAL

### **Application Refused--Section 2(e)(4)—Mark is Primarily Merely a Surname**

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17-18, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *see* TMEP §§1211, 1211.01.

The applicant applied to register the mark VALENTINO for financial services, food and beverage services, providing temporary accommodations, and heating, cooling, cooking, and steam generating apparatus.

The following five factors are used to determine whether a mark is primarily merely a surname:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

*In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

The examining attorney must consider the primary significance of the mark to the purchasing public to determine whether a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975). As evidenced by the attached references from Whitepages.com, VALENTINO is used primarily merely as a surname. This evidence shows the proposed trademark appearing at least 300 times as a surname in a nationwide telephone directory.

As indicated by the attached evidence, the surname is not unique. It has been held that “there is no

minimum number of telephone directory listings required to establish a prima facis case” in support of a surname refusal. *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1998); TMEP §1211.02(b)(i). The examining attorney notes that the applicant is VALENTINO, SPA which seems to indicate that someone connected with the applicant has used the mark as his or her surname. In addition, the proposed mark has the structure and pronunciation of a surname. Attached is a copy of the page from thefreedictionary.com wherein the term refers to Rudolph Valentino, a stage actor from the 1920s—a definition that supports the finding the term is primarily merely a surname. *See* TMEP §1211.02(b)(v).

Accordingly, the examining attorney refuses registration on the Principal Register pursuant to Section 2(e)(4) of the Trademark Act because the primary significance of the mark is that of a surname. Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4); TMEP §1211 *et seq.*

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

#### **Section 2(f) Suggested**

A mark deemed primarily merely a surname may be registered on the Principal Register under Trademark Act Section 2(f) by satisfying one of the following:

(1) Submitting a claim of ownership of one or more prior registrations on the Principal Register for a mark that is the same as the mark in the application and for the same or related goods and/or services. 37 C.F.R. §2.41(b); TMEP §1212.04. The following wording is suggested: **“The mark has become distinctive under Section 2(f) of the goods or services as evidenced by ownership of U.S. Registration No(s). \_\_\_\_\_ [applicant must supply] on the Principal Register for the same mark for related goods or services.”** TMEP §1212.04(e).;

(2) Submitting the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: “The mark has become distinctive of the goods and/or services through applicant’s substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.” 37 C.F.R. §2.41(b); TMEP §1212.05(d).; or

(3) Submitting actual evidence of acquired distinctiveness. 37 C.F.R. §2.41(a); TMEP §1212.06. Such evidence may include the following: examples of advertising and promotional materials that specifically promote the applied-for mark as a trademark or service mark in the United States; dollar figures for advertising devoted to such promotion; dealer and consumer statements of recognition of the applied-for mark as a trademark or service mark; and any other evidence that establishes recognition of the applied-for mark as a source-identifier for the goods and/or services. *See In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp. of Am.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

Trademark Act Section 2(f), 15 U.S.C. §1052(f); *see* 37 C.F.R. §2.41; TMEP §§1211, 1212.

#### **Supplemental Register Not Available—Applicant May Overcome Refusal Based On A Claim Of**

### **Acquired Distinctiveness Pursuant To Section 2(f)**

The applicant cannot overcome the Section 2(e)(4) refusal by amending the application to the Supplemental Register, because a mark in an application under §66(a) of the Trademark Act is not eligible for registration on the Supplemental Register. Trademark Act Section 68(a)(4), 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c); TMEP §§801.02(b), 815, 816.01 and 1904.02(c). The above stated refusal may be withdrawn however if the applicant can successfully demonstrate that the proposed mark has acquired distinctiveness under Section 2(f) of the Trademark Act. *See* 15 U.S.C. §1052(f).

### **Advisory Regarding A Claim Of Acquired Distinctiveness Under Section 2(f) Based On Five Years Use**

The applicant may overcome the refusal by amending the application to seek registration on the Principal Register pursuant to Trademark Act Section 2(f) if the applicant has used its mark for a significant period of time in commerce that may be lawfully regulated by the United States Congress. *See* 15 U.S.C. §1052(f); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); TMEP §1212.08. This use in commerce must be substantially exclusive and continuous for **at least five years** prior to the date the amendment to Section 2(f) is requested. 15 U.S.C. §1052(f); TMEP §1212.05.

To amend the application to Section 2(f) based on five years' use, the applicant should provide information regarding the length of use of the mark in commerce and/or dates of use, and include the following written statement claiming acquired distinctiveness, if accurate:

**The mark has become distinctive of the goods and/or services through applicant's substantially exclusive and continuous use in a type of commerce that the U.S. Congress can regulate for at least the five years immediately before the date of this statement.**

*See* TMEP §§1010, 1212.05(d). The applicant must verify this statement with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33. 37 C.F.R. §2.41(b); TMEP §1212.05(d). For your convenience, the examining attorney has enclosed a properly worded declaration below.

**PLEASE NOTE:** In establishing acquired distinctiveness, the applicant may **not** rely on use other than use in commerce that may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999); TMEP §§1010, 1212.08.

### **Suggested Affidavit Form**

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of the response, the applicant should insert the declaration signed by someone authorized to sign under 37 C.F.R. §2.33(a).

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true, that the applicant is the owner of the mark sought to be registered, that the applicant is using the mark in commerce in connection with the goods and/or services identified in the application, that

the mark has become distinctive of the goods and/or services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement, that all statements made of his/her own knowledge are true, and that all statements made on information and belief are believed to be true.

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name and Position)

\_\_\_\_\_  
(Date)

If the declaration is filed electronically through TEAS, then applicant should sign the declaration by entering a "symbol" that applicant has adopted as a signature (e.g., */john doe/*, */dr/*, and */544-4925/*). The Office will accept *any* combination of letters, numbers, spaces and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols. 37 C.F.R. §§ 2.33(d) and 2.193(c)(1)(iii); TMEP §§304.08 and 804.05.

**Advisory Regarding A Claim Of Acquired Distinctiveness Under Section 2(f) Based On Evidence Supporting Proof Of Distinctiveness**

Alternatively, if the applicant believes that its mark has acquired distinctiveness in the United States, that is, that it has become a distinctive source indicator for the goods and/or services, the applicant may overcome the above-stated refusal by seeking registration on the Principal Register under Trademark Act Section 2(f) based on such evidence of distinctiveness. *See* 15 U.S.C. §1052(f); TMEP §§1010, 1212.08. The Office will decide each case on its own merits.

In determining whether the proposed mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; *see* TMEP §§1212 *et seq.*

Evidence of acquired distinctiveness may include specific dollar sales under the mark, advertising figures, samples of advertising, and consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. *See* 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

**PLEASE NOTE:** In establishing acquired distinctiveness, the applicant may **not** rely on use other than use in commerce that may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999); TMEP §§1010, 1212.08.

### III. INFORMALITIES

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following issue(s):

**Applicant Improperly Identified the Goods and/or Services**

The applicant has provided this Office with the following identification:

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, in International Class 011;

Insurance; financial affairs; monetary affairs; real estate affairs; in particular management of business investments in companies in the field of clothing, in International Class 036; and

Services for providing food and drink; temporary accommodation, in International Class 043.

The wording in the recitation of goods and services is unacceptable as indefinite and must be clarified. TMEP §1402.01. Based on the applicant's description, the examining attorney cannot determine the kinds of lighting, heating, cooking, drying, and sanitary apparatus, or the nature of the applicant's accommodation, insurance, financial affairs, and real estate services. The language the applicant used fails to adequately describe these products and services such that the average person would readily understand what the goods and services are.

In this case, the applicant used the class headings as its identification of goods and services. These headings are meant to indicate the subject matter and general scope of each international class of goods and services. While such broad designations may be sufficient under the trademark laws and practice of other countries, the Office considers them too broad to identify goods or services in a U.S. application. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986); *see* TMEP §§1401.08, 1402.01 *et seq.* Therefore, the applicant must amend the goods and services to specify the common commercial or generic name for each product or service.

The applicant must amend the recitation to specify the common commercial name of the goods and services. If there is no common commercial name for the products and services, the applicant must adequately describe the nature of the goods and services and their main purpose, as well as indicate the channel of trade, intended consumer and intended use(s). The applicant may amend the identification to substitute the following wording, if accurate:

Proposed identification for International Class 011:

Apparatus for lighting, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* electric lighting fixtures, lighting tracks, lighting fixture, chandeliers]; apparatus for heating, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* electric heating fans, electric radiators for heating buildings, industrial heating furnaces]; apparatus for steam generating, namely, \_\_\_\_\_ [applicant must identify the

good using its common commercial name *e.g.* electric steam radiators for heating buildings, steam generators, industrial steam heating apparatus]; apparatus for cooking, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* electric cooking ovens, microwave ovens, electric cooktops]; apparatus for refrigerating, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* refrigerating machines, refrigerators, refrigerated shipping containers]; apparatus for drying, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* clothes dryers, industrial dryers for heating and dehumidifying, household hair dryers]; apparatus for ventilating, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* ventilating exhaust fans, ventilating fans for commercial and industrial use, ventilating louvers]; apparatus for water supply and sanitary purposes, namely, \_\_\_\_\_ [applicant must identify the good using its common commercial name *e.g.* industrial-water purifying apparatus, water distillation units, tap water faucets, waste water purification units, sanitary installations in the nature of urinals].

Proposed identification for International Class 036:

Insurance, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* insurance administration, life insurance underwriting, insurance consultation, insurance claims administration]; financial and monetary affairs, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* financial forecasting, financial planning services, mortgage and consumer lending services, financial research and financial management]; real estate affairs, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* real estate appraisal, real estate brokerage, real estate investment, real estate management]; management of business investments in companies in the field of clothing, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* Investment management for companies in the field of clothing].

Proposed identification for International Class 043:

Services for providing food and drink, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* serving food and drinks, catering of food and drinks, serving of food and drink/beverages, providing of food and drink for patients and guests]; temporary accommodation, namely, \_\_\_\_\_ [applicant must describe the service using its common commercial name *e.g.* providing temporary accommodation, providing temporary housing accommodations, arranging temporary housing accommodations].

**PLEASE NOTE:** While an identification of goods or recitation of services can be amended only to clarify or limit the goods and/or services, adding to or broadening the scope of the goods and/or services is **not** permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, the applicant may not amend the identification to include any products or services that are not within the scope of the goods and/or services originally set forth in the application or a previously accepted

amendment thereto. TMEP §1402.06(b).

In addition, the international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b).

#### Online Identification Reference Provided By The USPTO

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/ncathtml/tidm.html>. See TMEP §1402.04.

#### Applicant Must Claim Ownership Of Prior Registrations

If the applicant is the owner of U.S. Registration Nos. 3298206, 0956665, 2826869 and 2755270 then the applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration Nos. 3298206, 0956665, 2826869 and 2755270 and others.

#### Applicant's Response

There is no required format or form for responding to an Office action. When responding to this Office action, the applicant must make sure to respond in writing to each refusal and requirement raised. If a refusal has issued, the applicant can argue against the refusal. If a requirement has issued, the applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

The applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the trademark examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant's name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a). The response must be personally signed or the electronic signature manually entered by the applicant or someone with legal authority to bind the applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

To expedite prosecution of this application, the applicant is strongly encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/teas/index.html>.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Michael Tanner/

Michael Tanner  
Trademark Attorney

Law Office 117  
Telephone: 571-272-9706

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79059290
LAW OFFICE ASSIGNED	LAW OFFICE 117
MARK SECTION (no change)	
ARGUMENT(S)	<u>ARGUMENT</u>

Please see the argument text attached within the Evidence section.

### EVIDENCE SECTION

#### EVIDENCE FILE NAME(S)

ORIGINAL PDF FILE evi 2091832152-132508828 . 2868-223ARGUMENT.pdf

#### CONVERTED PDF FILE(S)

(2 pages)

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\\TICRS\EXPORT6\IMAGEOUT6\790\592\79059290\xml1\ROA0003.JPG

#### DESCRIPTION OF EVIDENCE FILE

ARGUMENT AGAINST 2(d) REFUSAL

### GOODS AND/OR SERVICES SECTION (011)(current)

INTERNATIONAL CLASS 011

#### DESCRIPTION

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes

### GOODS AND/OR SERVICES SECTION (011)(proposed)

INTERNATIONAL CLASS 011

#### TRACKED TEXT DESCRIPTION

~~Apparatus for lighting, heating, steam generating, cooling, refrigerating, drying, ventilating, water supply and sanitary purposes; ELECTRIC LAMPS, ELECTRIC CHANDELIERS AND ELECTRIC LIGHTING FIXTURES; LAMPS OF ALL KINDS, NAMELY, TABLE LAMPS, HANGING LAMPS, CHANDELIERS, WALL LAMPS, STANDARD LAMPS, CEILING LAMPS, HALOGEN LAMPS AND MODULAR LAMPS~~

**FINAL DESCRIPTION**

ELECTRIC LAMPS, ELECTRIC CHANDELIERS AND ELECTRIC LIGHTING FIXTURES; LAMPS OF ALL KINDS, NAMELY, TABLE LAMPS, HANGING LAMPS, CHANDELIERS, WALL LAMPS, STANDARD LAMPS, CEILING LAMPS, HALOGEN LAMPS AND MODULAR LAMPS

**GOODS AND/OR SERVICES SECTION (036)(current)**

**INTERNATIONAL CLASS** 036

**DESCRIPTION**

Insurance; financial affairs; monetary affairs; real estate affairs; in particular management of business investments in companies in the field of clothing

**GOODS AND/OR SERVICES SECTION (036)(proposed)**

**INTERNATIONAL CLASS** 036

**TRACKED TEXT DESCRIPTION**

~~Insurance; REAL ESTATE AGENCIES; financial affairs; REAL ESTATE INVESTMENT; monetary affairs; REAL ESTATE MANAGEMENT; real estate affairs; REAL ESTATE RENTAL SERVICES, NAMELY, RENTAL OF RESIDENTIAL HOUSING AND RENTAL OF VACATION HOMES; in particular management of business investments in companies in the field of clothing; REAL ESTATE SERVICES, NAMELY, LEASING AND MANAGEMENT FOR OTHERS OF RESIDENTIAL CONDOMINIUMS LOCATED WITHIN HOTEL DEVELOPMENTS~~

**FINAL DESCRIPTION**

REAL ESTATE AGENCIES; REAL ESTATE INVESTMENT; REAL ESTATE MANAGEMENT; REAL ESTATE RENTAL SERVICES, NAMELY, RENTAL OF RESIDENTIAL HOUSING AND RENTAL OF VACATION HOMES; REAL ESTATE SERVICES, NAMELY, LEASING AND MANAGEMENT FOR OTHERS OF RESIDENTIAL CONDOMINIUMS LOCATED WITHIN HOTEL DEVELOPMENTS

**GOODS AND/OR SERVICES SECTION (043)(current)**

**INTERNATIONAL CLASS** 043

**DESCRIPTION**

Services for providing food and drink; temporary accommodation

**GOODS AND/OR SERVICES SECTION (043)(proposed)**

**INTERNATIONAL CLASS** 043

**TRACKED TEXT DESCRIPTION**

services for providing food and drink; HOTEL SERVICES AND RESORT LODGE SERVICES;  
temporary accommodation

**FINAL DESCRIPTION**

HOTEL SERVICES AND RESORT LODGE SERVICES

**ADDITIONAL STATEMENTS SECTION****PRIOR REGISTRATION(S)**

Applicant claims ownership of U.S. Registration Number(s) 3298206, 0956665, 2826869 and others.

**SECTION 2(f)**

The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s) 3298206, 2755270, 2826869, 2880581, 2286240, 2312756, 1422015, 1419190, 1418315, 1268030, 1268029, 1140394, 0956665, 0951621, 0916465, 0910955, 0899841, 0901896.

**MISCELLANEOUS  
STATEMENT**

Applicant has appointed the undersigned as Attorney of Record/Domestic Representative and will submit a properly executed Power of Attorney upon receipt. The undersigned is responding based on implied authority. Please correspond with the law firm of Rothwell, Figg, Ernst & Manbeck.

**CORRESPONDENCE SECTION****NAME**

G. Franklin Rothwell

**FIRM NAME**

Rothwell, Figg, Ernst & Manbeck, pc

**INTERNAL ADDRESS**

Suite 800

**STREET**

1425 K Street NW

**CITY**

Washington

**STATE**

District of Columbia

**ZIP/POSTAL CODE**

20005

**COUNTRY**

United States

**PHONE**

(202) 783-6040

**FAX**

(202) 783-6031

**SIGNATURE SECTION****RESPONSE SIGNATURE**

/Anne M. Sterba/

**SIGNATORY'S NAME**

Anne M. Sterba

**SIGNATORY'S POSITION**

Attorney of record, DC bar member

**DATE SIGNED**

05/06/2009

**AUTHORIZED**

**AUTHORIZED  
SIGNATORY**

YES

**FILING INFORMATION SECTION**

**SUBMIT DATE** Wed May 06 15:57:21 EDT 2009

**TEAS STAMP**

USPTO/ROA-209.183.215.2-2  
0090506155721536871-79059  
290-4301c2f3c1c7049f7f559  
c27984813bbd3-N/A-N/A-200  
90506132508828419

FILED MAY 11 2009  
WASHINGTON, DC

**Response to Office Action  
To the Commissioner for Trademarks:**

Application serial no. **79059290** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

**ARGUMENT**

Please see the argument text attached within the Evidence section.

**EVIDENCE**

Evidence in the nature of ARGUMENT AGAINST 2(d) REFUSAL has been attached.

**Original PDF file:**

evi\_2091832152-132508828\_2868-223ARGUMENT.pdf

**Converted PDF file(s) (2 pages)**

Evidence-1

Evidence-2

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 011 for Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes

Original Filing Basis:

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; ELECTRIC LAMPS, ELECTRIC CHANDELIERS AND ELECTRIC LIGHTING FIXTURES; LAMPS OF ALL KINDS, NAMELY, TABLE LAMPS, HANGING LAMPS, CHANDELIERS, WALL LAMPS, STANDARD LAMPS, CEILING LAMPS, HALOGEN LAMPS AND MODULAR LAMPS~~ Class 011 for ELECTRIC LAMPS, ELECTRIC CHANDELIERS AND ELECTRIC LIGHTING FIXTURES; LAMPS OF ALL KINDS, NAMELY, TABLE LAMPS, HANGING LAMPS, CHANDELIERS, WALL LAMPS, STANDARD LAMPS, CEILING LAMPS, HALOGEN LAMPS AND MODULAR LAMPS

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 036 for Insurance; financial affairs; monetary affairs; real estate affairs; in particular management of business investments in companies in the field of clothing

Original Filing Basis:

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Insurance; REAL ESTATE AGENCIES; financial affairs; REAL ESTATE INVESTMENT; monetary affairs; REAL ESTATE MANAGEMENT; real estate affairs; REAL ESTATE RENTAL SERVICES, NAMELY, RENTAL OF RESIDENTIAL HOUSING AND RENTAL OF VACATION HOMES; in particular management of business investments in companies in the field of clothing; REAL ESTATE SERVICES, NAMELY, LEASING AND MANAGEMENT FOR OTHERS OF RESIDENTIAL CONDOMINIUMS LOCATED WITHIN HOTEL DEVELOPMENTS~~ Class 036 for REAL ESTATE AGENCIES; REAL ESTATE INVESTMENT; REAL ESTATE MANAGEMENT; REAL ESTATE RENTAL SERVICES, NAMELY, RENTAL OF RESIDENTIAL HOUSING AND RENTAL OF VACATION HOMES; REAL ESTATE SERVICES, NAMELY, LEASING AND MANAGEMENT FOR OTHERS OF RESIDENTIAL CONDOMINIUMS LOCATED WITHIN HOTEL DEVELOPMENTS

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 043 for Services for providing food and drink; temporary accommodation

Original Filing Basis:

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Services for providing food and drink; HOTEL SERVICES AND RESORT~~

~~LODGE SERVICES; ~~\*\*\*\*\*~~\*\*\*\*\*~~ Class 043 for HOTEL SERVICES AND RESORT  
LODGE SERVICES

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**CORRESPONDENCE ADDRESS CHANGE**

Applicant proposes to amend the following:

**Current:**

JACOBACCI & PARTNERS S.P.A.  
Via Senato, 8  
I-20121 MILANO  
ITALY

**Proposed:**

G. Franklin Rothwell of Rothwell, Figg, Ernst & Manbeck, pc, having an address of  
Suite 800 1425 K Street NW Washington, District of Columbia 20005  
United States  
(202) 783-6040  
(202) 783-6031

**ADDITIONAL STATEMENTS**

**Claim of Prior Registration(s)**

Applicant claims ownership of U.S. Registration Number(s) 3298206, 0956665, 2826869 and others.

**Section 2(f), based on Prior Registration(s)**

The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s) 3298206, 2755270, 2826869, 2880581, 2286240, 2312756, 1422015, 1419190, 1418315, 1268030, 1268029, 1140394, 0956665, 0951621, 0916465, 0910955, 0899841, 0901896.

Applicant has appointed the undersigned as Attorney of Record/Domestic Representative and will submit a properly executed Power of Attorney upon receipt. The undersigned is responding based on implied authority. Please correspond with the law firm of Rothwell, Figg, Ernst & Manbeck.

**SIGNATURE(S)**

**Response Signature**

Signature: /Anne M. Sterba/ Date: 05/06/2009

Signatory's Name: Anne M. Sterba

Signatory's Position: Attorney of record, DC bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to

withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.


Mailing Address: G. Franklin Rothwell  
Rothwell, Figg, Ernst & Manbeck, pc  
Suite 800  
1425 K Street NW  
Washington, District of Columbia 20005


Serial Number: 79059290  
Internet Transmission Date: Wed May 06 15:57:21 EDT 2009  
TEAS Stamp: USPTO/ROA-209.183.215.2-2009050615572153  
6871-79059290-4301c2f3c1c7049f7f559c2798  
4813bbd3-N/A-N/A-20090506132508828419


## ARGUMENT AGAINST 2(d) REFUSAL


The Office has initially refused registration based on an alleged likelihood of confusion with the following registrations and a potential likelihood of confusion with the following applications:

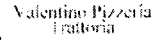
1) Reg. No. 1,820,548 for VALENTIN for “shower equipment sold as a unit: namely, nozzles, massaging and regular shower heads, hoses, adjustable, sliding and swivel brackets, wall outlets, sockets and cradles,” in Class 11, owned by Valentin S.A.:

2) Reg. No. 1,210,075 for  for “restaurant services,” in Class 43, owned by Valentino’s of America, Inc. and the registration is geographically limited;

3) Reg. No. 1,210,072 for  for “restaurant services,” in Class 43, owned by Valentino’s of America, Inc. and the registration is geographically limited;

4) Apn. No. 77/041,108 for  for “administrative hotel management; business administration and management; business management; business management of hotels for others” in Class 35; “hotel, bar and restaurant services; hotels” in Class 43; and “Business cards; cachets; informational letters concerning hotels; letterhead paper; paper; paper drop cloths; publications, namely, brochures, booklets, and teaching materials in the field of hotels,” in class 16, owned by Valentin Gestion S.L.:

5) Apn. No. 77/410,807 for  for “bar and restaurant services,” in Class 43, owned by Stacy Dangleish:

6) Apn. No. 77/346,274 for  for “cafe and restaurant services: Cafe-restaurants; Restaurant; Restaurant and cafe services; Restaurant services; Restaurants; Restaurants featuring home delivery; Take-out restaurant services; Carry-out restaurants; Restaurant and catering services,” in Class 43, owned by Michael T. Valentino:

7) Apn. No. 75/004,284 for VALENTINO for “restaurant and catering services,” in Class 43, owned by Zum Ritter, Inc. and is subject to a concurrent use proceeding;

8) Apn. No. 76/156,579 for PIERO SELVAGGIO VALENTINO for “restaurant services, bar services, catering services, providing facilities for banquets, social functions, and special events” in Class 43, owned by Valentino Las Vegas, LLC and is subject to a concurrent use proceeding; and


9) Apn. No. 74/341,624 for VALENTINO’S for “restaurant services,” in Class 43, owned by Val Limited, Inc. and is subject to a concurrent use proceeding.

Applicant respectfully traverses the refusals and requests that the Office reconsider its position considering the changes in the identification of goods/services and the below arguments.

(1) Reg. No. 1,820,548 for VALENTIN in Class 11



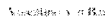
Based on the changes in Applicant's identification of goods, Applicant respectfully requests that the refusal be withdrawn.

(2) and (3) Reg. No. 1,210,075 and 1,210,072 for  in Class 43

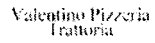
Applicant respectfully traverses the argument that its proposed mark is confusingly similar to the cited registrations because the services, as amended, are sufficiently different so as not to cause confusion. Applicant has amended its recitation of services to exclude any reference to food and beverage services. Therefore, the services do not overlap and are not related.

(4) Apn. No. 77/041,108 for  in Classes 35, 43 and 16

Applicant elects to withhold its comments regarding this application until and if it matures into registration.

(5) Apn. No. 77/410,807 for  in Class 43

Applicant elects to withhold its comments regarding this application until and if it matures into registration.

(6) Apn. No. 77/346,274 for  in Class 43

Applicant elects to withhold its comments regarding this application until and if it matures into registration.

(7) Apn. No. 75/004,284 for VALENTINO in Class 43

Applicant elects to withhold its comments regarding this application until and if it matures into registration.

(8) Apn. No. 76/156,579 for PIERO SELVAGGIO VALENTINO in Class 43

Applicant elects to withhold its comments regarding this application until and if it matures into registration.

(9) Apn. No. 74/341,624 for VALENTINO'S in Class 43

Applicant elects to withhold its comments regarding this application until and if it matures into registration.